

REMARKS

Applicant hereby traverses the outstanding rejections, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 15 and 17 are indicated as having allowable material. Claims 1-20 are pending in this application.

Rejection under 35 U.S.C. § 103(a)

Claims 1-14, 16, and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moore ('729) in view of Rhoads ('819).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second, Applicant asserts that the rejection does not satisfy the first and third criteria.

The recited combination does not teach or suggest all claimed limitations.

The Office Action admits that Moore does not teach "create a second data from a first data". The Office Action attempts to cure this deficiency by introducing Rhoads, which the Office Action alleges to teach having such an element. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a method that comprises "modifying the data within said first data set to create a second data arrangement for said first data set". The Office Action states the Moore does not teach this limitation. Rhoads also does not teach this limitation. The Office Action states that data 15 of Rhoads corresponds to the claimed first data set, and the signal 20 corresponds to the second data arrangement. However, nothing in Rhoads discloses that the signal 20 is created by modifying the data 15. Thus, the combination of Moore and Rhoads does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 18 defines a system comprising “a first data set having a first data arrangement, the data within said first data set being modifiable to create a second data arrangement for said first data set”. The Office Action states the Moore does not teach this limitation. Rhoads also does not teach this limitation. The Office Action states that data 15 of Rhoads corresponds to the claimed first data set, and the signal 20 corresponds to the second data arrangement. However, nothing in Rhoads discloses that the signal 20 is created by modifying the data 15. Thus, the combination of Moore and Rhoads does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 18 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 20 defines a system comprising “a data processing system for modifying data ... having a first data arrangement to create a second data arrangement for said data”. The Office Action states the Moore does not teach this limitation. Rhoads also does not teach this limitation. The Office Action states that data 15 of Rhoads corresponds to the claimed first data arrangement, and the signal 20 corresponds to the second data arrangement. However, nothing in Rhoads discloses that the signal 20 is created by modifying the data 15. Thus, the combination of Moore and Rhoads does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 20 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-14, 16, and 19 depend from base claims 1 and 18, respectively, and thus inherit all limitations of their respective base claims. Each of claims 2-14, 16, and 19 sets forth features and limitations not recited by the combination of Moore and Rhoads. Thus, the Applicant respectfully asserts that for the above reasons claims 2-14, 16, and 19 are patentable over the 35 U.S.C. § 103(a) rejection of record.

The Office Action does not provide the requisite motivation.

The Office Action admits that Moore does not teach “create a second data from a first data”. The Office Action attempts to cure this deficiency by introducing Rhoads, which the Office Action alleges to teach having such an element. The motivation for making the combination was presented as follows:

“it would have obvious ... to modify Moore according to the teaching of Rhoads because it provides a method to track subsequent use of digital images including derivative images, which identify the source or ownership of images and distinguish between different copies and verify the authenticity of the document from forgery.”

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. Applicant notes that Moore already provides an anti-counterfeiting and tracking system, and thus does not require the teachings of Rhoads to this end. Therefore, the recited motivation is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

No valid suggestion has been made as to why a combination of Moore and Rhoads is desirable. Therefore, the rejection of claims 1-14, 16, and 18-20 should be withdrawn.

Conclusion

The Examiner is thanked for the indication that claims 15 and 17 include allowable subject matter.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004878-1, from which the undersigned is authorized to draw.

Dated: June 11, 2004

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Date of Deposit: June 11, 2004

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